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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/729,871	12/05/2003	Shigeaki Hakusui	2747/103	8488

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BROMBERG & SUNSTEIN LLP
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BOSTON, MA 02110-1618

EXAMINER

SMITH, CREIGHTON H

ART UNIT	PAPER NUMBER
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2645

DATE MAILED: 08/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/729,871	Applicant(s) HAKUSUI, SHIGEAKI	
	Examiner Creighton H. Smith	Art Unit 2645	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 July '05.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 21 and 22 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>12/27/04</u> | 6) <input type="checkbox"/> Other: _____ |

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 2, 15, are rejected under 35 U.S.C. 102(e) as being anticipated by Beyda, U.S. Publication #2003/0206546.

Applicant argues that their feature server is a “built-in” device with the internet telephony device. However, applicant discloses on page 7 that the feature server (VoIP modem- 400) is a stand alone element because “the VoIP modem 400 includes a telephone interface 410 into which a standard analog telephone can be connected . . .”

Applicant's figure 2 even shows the VoIP modem being connected with phone 450 and not built into the phone 450. Therefore, applicant's claims are anticipated by Beyda because Beyda's phones 102a, 102b are also connected to the feature server 105

Beyda discloses in his Abstract a system that includes a packet network (the Internet); a plurality of VoIP endpoints/IP telephony devices, [0002]. Beyda's VoIP terminal's 102a, 102b are able to send configuration request messages to the feature servers. The feature servers respond with information indicative of supported features, allowing the VoIP endpoints to update their system configurations based on the response information from the feature servers. Beyda discloses in [0026] an illustration of his feature server. The feature server could be either of a gateway, gatekeeper,

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MCU, or TFA server (106,108, 104, 105) as shown in Fig. 1, located between a PBX (103) and users IP telephone terminals (102a, 102b). Inside of the feature server is a controller (302), along with a configuration unit. The configuration unit receives requests from the user's IP phones and will provide the desired information back to the users' IP phones. Beyda never specifically discloses a network interface, nor a telephone interface. However, both of these elements that applicant has claimed are inherently in Beyda's apparatus because as shown in Fig. 1, the feature server (either elements 108, 106, 104, or 112) are shown located between the PBX (103) and the user IP phones (102a, 103b), and for Beyda's apparatus to work between these separate and distinct entities there must be some type of interface. Regarding claim 2, for the users' IP phones the ring, the signal from the PSTN will come through the PBX, with the signal coming through the PBX going into the feature server, and then the ring signal going on to the IP phones. Therefore, inherently, the controller will ring the users' IP device over the telephone interface.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3-14, 16-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Beyda, U.S. Publication #2003/0206546 in view of Haserodt, U.S. Patent #6031836.

Haserodt discloses in col. 1, lines 20-35 that telephony features can be provided to computers or terminals on a LAN via a feature server. Those features may include, without limitation, call forwarding, multiple call appearances (hold, drop, transfer, conference), call center agent features, call center information management features, and calling party management information features. In col. 3, lines 41-47/48, Haserodt discloses that the clients 101, 102 are able to select and activate or deactivate telephony features and to specify and enter parameters for those features. To have used Haserodt's teaching of the multiple features that could be downloaded onto a users' IP phone, and to have placed simultaneous ringing in those group features would have been obvious to a person having ordinary skill in the telephony art. The motivation for making this modification is that Haserodt has only listed some examples of the features that can be downloaded onto the users' phone. His recital of "without limitation" gives one of ordinary skill in the art the ability to think of more features that possible could be downloaded onto Beyda's IP phones, such as simultaneous ringing. For claim 5, Haserodt discloses the feature of call forwarding in col. 5, line 30.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication should be directed to Creighton H Smith at telephone number 571/272-7546.

11 AUG '05

A handwritten signature in black ink, appearing to read "Creighton H. Smith", written in a cursive style.

Creighton H Smith
Primary Examiner
Art Unit 2645